

REMARKS

The Office Action indicates that claim 1 is pending. Applicant filed a Preliminary Amendment on June 18, 2003 canceling claim 1 and presenting new claims 2 and 3. A copy of the Preliminary Amendment is attached (Attachment A). A copy of the postcard acknowledging receipt of the Preliminary Amendment by the USPTO is also attached (Attachment B).

Claim 1 is rejected based on double patenting under 35 U.S.C. §101 over claim 1 of US. Patent No. 6,673,116 (the '116 Patent). Claim 1 has been canceled.

Claims 2 and 3 remain pending in the application. Applicant does not believe that claims 2 and 3 present a double patenting issue under 35 U.S.C. §101 with respect to the '116 Patent. Claim 1 of the '116 patent defines an intramedullary guidance system comprising a guide pin and a cutting guide. Claims 2 and 3 of the instant application are directed to an ankle prosthesis system comprising a jig sized to fit in an ankle joint between a tibia and a talus and a prosthesis. Therefore, the claims are not directed to the same invention under 35 U.S.C. §101 (no statutory double patenting). Furthermore, the differences defined are non-obvious (no obviousness-type non-statutory double patenting).

Reconsideration in view of the foregoing amendments and remarks and allowance of claims 2 and 3 is respectfully requested.

Respectfully Submitted,

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13 August 2004

Customer No.: 26308

Reiley/17206-CP 2 DIV/040813 Amendment A

Enclosures: Amendment Transmittal Letter  
Attachment A  
Attachment B  
Return Postcard



Customer No.: 26308

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Reiley

Docket No.: 9414.17206-CIP 2 DIV

Serial No.: 10/699,999

Examiner: Unknown

Filed: 3 November 2003

Group Art Unit: 3732

Title: Intramedullary Guidance Systems and Methods for Installing Ankle Replacement Prostheses

PRELIMINARY AMENDMENT

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

The Examiner's attention is directed to the Information Disclosure Statement that accompanies this Amendment.

Please amend the application prior to the first Office Action and calculation of fees as follows:

AMENDMENTS TO THE CLAIMS

1 (Canceled).

2 (New). An ankle replacement prosthesis system comprising

a jig sized to fit in an ankle joint between a tibia and a talus to guide formation of a prosthesis-receiving cavity that traverses a joint between the talus and a calcaneus, the jig including a post sized to rest in an intramedullary passage formed through the calcaneus and talus adjacent the ankle joint to orient the jig during formation of the prosthesis-receiving cavity, the post accommodating removal of the jig after formation of the prosthesis-receiving cavity, and

a prosthesis including a talo-calcaneal stem sized to extend within the prosthesis-receiving cavity and prevent movement of the joint between the talus and the calcaneus, the talo-calcaneal stem including an inferior portion sized to attach to a calcaneus and a superior portion sized to attach to the talus and support an artificial joint surface that engages another prosthesis on the tibia.

3 (New). An ankle replacement prosthesis system comprising

a jig sized to fit in an ankle joint between a tibia and a talus to guide resection of end regions of the tibia and talus, the jig including a post sized to rest in an intramedullary passage formed through the tibia and the talus adjacent the ankle joint to orient the jig during the resection, the post accommodating removal of the jig after the resection,

an upper prosthesis including a stem sized to extend within the intramedullary passage in the tibia and support an artificial upper joint surface, and

a lower prosthesis including a talo-calcaneal stem sized to traverse the joint between the talus and the calcaneus and prevent movement of the joint, the talo-calcaneal stem including an inferior portion sized to attach to a calcaneus and a superior portion sized to attach to the talus and support an artificial lower joint surface that engages the artificial upper joint surface.

REMARKS

Claim 1 has been canceled.

New claims 2 and 3 are presented for prosecution.

Claims 2 and 3 remain pending in the application. Support for the subject matter of claims 2 and 3 can be found in the specification as filed (e.g., page 17, line 13 to page 18, line 13, and Figs. 9 and 9A-9C). No new matter has been added.

Entry of this Preliminary Amendment and allowance of claims 2 and 3 is respectfully requested.

Respectfully Submitted,

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Reiley/1720-CIP 2 D1W/040611 Preliminary Amendment

Enclosures: Amendment Transmittal Letter  
Return Postcard



FILED IN THE UNITED STATES PATENT & TRADEMARK OFFICE

PAL/lsw

Serial No.: 10/699,999

Title: Intramedullary Guidance Systems and Methods for Installing  
Ankle Replacement Prostheses

Applicant: Reiley

Date Mailed: 18 June 2004

via First Class Mail

Docket #: 9414.17206-CIP 2 DIV

Enclosures: Amendment Transmittal Letter; Preliminary Amendment;  
Transmittal of Information Disclosure Statement; Information  
Disclosure Statement; return postcard

